

REMARKS

In the Office Action, claims 1-20 were rejected under 35 USC §112, first paragraph. Claims 1-20 were rejected under 35 USC §112, second paragraph. Claims 1-11, 14-15 and 18-19 were rejected under 35 USC §102(b) as being anticipated by Fabre. Claims 12, 13, 16, 17 and 20 were rejected under 35 USC §103(a) as being unpatentable over Fabre. Claims 1-12 and 14-15 were rejected under 35 USC §102(b) or (3) as being anticipated by Wolfe. Claims 13 and 16-20 were rejected under 35 USC §103(a) as being unpatentable over Wolfe.

The Examiner has rejected claims 1 to 20 as being indefinite under 35 U.S.C. 112, first paragraph for failing to comply with the written description requirement on the basis that the limitation "non-interchangeable" added to claim 1 was not described in the disclosure as originally filed. The Applicant cancels the new matter as requested and deletes the word "non-interchangeable" from claim 1. Since claims 2 to 20 depend on claim 1, the Applicant asks that this objection to claims 1 to 20 be withdrawn.

The Examiner has also rejected the limitation "non-interchangeable" added to claim 1 under 35 U.S.C. 132. The Applicant requests that this objection be withdrawn because the word "non-interchangeable" has been deleted from claim 1.

The Examiner has also rejected claims 1 to 20 under 35 U.S.C. 112, second paragraph. The Applicant asks that these objections be withdrawn in view of the amendment to claim 1 and the dependencies of claims 2 to 20 on claim 1.

A sample of the inventive elements are included for the Examiner's review when considering the arguments set forth herein below.

The Examiner has rejected claims 1-11, 14-15 and 18-19 as being anticipated under 35 U.S.C. 102(b) in view of Fabre. The Examiner states that Fabre discloses a set of elements having all the structural elements of the claims. The Examiner then concludes that the devices of Fabre "are presumed to be inherently capable of all of the claimed functions" on this basis. The Examiner states at paragraph 12 that "it is believed to be well settled that a claim to a product does not avoid prior art showing all of the claimed structure merely because the claim recites a different function than disclosed by the prior art."

In response, the Applicant traverses this issue and adds new claims 24 and 25. The Applicant submits that the Examiner has failed to establish a prima facie case of anticipation as described by MPEP Section 2112.01 and the case law therein because a "sound basis" for believing that the products are the same has not been provided.

First, the Examiner has not demonstrated how the devices in Fabre teach every element of the claim in the present invention as required by 35 U.S.C. 102(b) and MPEP Section 2112.01 and the cases therein. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628). "The identical invention must be shown in as complete detail as is contained in the ... claim". (See *Richardson v. Suzuki Motor Co.*, 868 F. 2d. 1226).

The Examiner's cited reference to element 10 of Fabre does not support the conclusion that all of the structural elements of the present invention are contained therein. The structural elements are not identical because the present invention is physically incapable of performing the interlocking function claimed by Fabre. Fabre expressly identifies the constructional elements therein as being "composable and/or conformable ... by mutual engagements as accomplished by inserting the members for one element into the cavities or holes of another element or the same element." An additional purpose of "supporting and /or connecting one or more of said constructional elements" is also identified, but the means of providing this supporting function is expressly described as "accommodate by a slight resilient forcing a member of one or more constructional elements."

Second, the Examiner has not provided a basis for his "presumption" that the Fabre devices are inherently capable of all of the functions claimed by the present invention. As noted at MPEP Section 2112 in the discussion of *Ex parte Levy*, 17 US PQ 2d 1461, "the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."

Fabre fails to teach how to practice the limiting function cited at lines 7-14 of claim 1 by the Examiner. In particular, it fails to teach the stated placement of the body portion of a protrusion in abutting contact with the edge of another member in order to anchor the second member and prevent sliding. Instead, Fabre merely teaches identified "side advantages" including "the possibility of piling up many constructional elements having the same shape and size so as to obtain a very small oversize packing."

Where there is no mention of the asserted inherent characteristic, MPEP 2131.01 requires the Examiner to provide extrinsic evidence to make clear that the missing descriptive matter is necessarily present in the reference. Inherency cannot be based on a result that would arise due to optimizing conditions not necessarily present in the prior art. The fact that a certain result or characteristic may occur or be present in the prior art

is not sufficient to establish its inherency. See MPEP 2112 and the discussion of *In re Oelrich*, 666 F.2d. and *In re Rijckaert*, 9 F.3d. 1531.

In summary, the Applicant submits that the Examiner has failed to explain how the Fabre reference is substantially identical to the present invention. The Examiner has further failed to provide evidence of the missing descriptive matter to establish that it is inherent and necessarily present in the Fabre device. The Applicant submits that the burden of proof has not shifted to the Applicant because the Examiner has failed to make a prima facie case.

In the alternative event that the prima facie case has been made and the burden of proof has shifted, the Applicant submits that Fabre teaches members that are hollow and function as male and female joint members on a flat base which is preferably flexible. The external surface of each member may have a molding or rib defining the inner surface for snap engaging a rib of another member, thus increasing the grip and resistance against unthreading. Fabre claim 1 requires that the concave depressions in the sheet must have a depth at least one third of the depression diameter. None of these requirements are mandatory in the claims for the present invention. To the contrary, claim 1 requires that the elements are for easily disassembled structures. The requirements of easy disassembly in the present invention are not

compatible with the mutually exclusive condition in Fabre that the depressions in the elements must be capable of forming a shape-conforming locking relationship with any other depression. Fabre does not inherently teach the placement of the body portion of a protrusion in abutting contact with the edge of another member. It teaches and emphasizes placement of the body portion inside another member in order to anchor the members. The Applicant respectfully requests that the objection be withdrawn.

In addition, the Applicant has introduced limiting elements in new claims 24 and 25 in order to further distinguish these claims from the elements disclosed in Fabre. The Applicant states that all elements are previously described in the disclosure and do not constitute New Matter.

The Examiner has rejected claims 12, 13, 16, 17 and 20 as being obvious under 35 U.S.C. 103(a) in view of Fabre. The Examiner states that the Fabre reference discloses "most of the elements" of these claims "as indicated above with respect to claims from which claims 12, 13, 16, 17 and 20 depend". The Examiner finds that Fabre does not teach the "specific limitations" of the claims and concludes that "on the other hand, it would have been obvious to construct the devices of Fabre as claimed, for the purpose of facilitating easier use thereof."

The Applicant traverses on this issue and adds new claims 24 and 25 which include elements of previous claims. It is

submitted that obviousness can only be established where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. All claim limitations must be taught or suggested by the prior art and an "obvious to try" approach is improper. See MPEP Section 2143.01, 2143.03 and 2145. The Applicant submits that the Examiner has provided a conclusory statement of motivation, that the Fabre device would be constructed as claimed "for the purpose of facilitating easier use thereof", without any articulated rationale or evidentiary support. This does not constitute the sufficient factual finding necessary to support an obviousness rejection as required by MPEP Section 2144.08.

The Examiner suggests that the configuration of Fabre could be modified as claimed in claims 12, 13, 16, 17 and 20. However, such modification would render the Fabre device unsatisfactory for its identified intended purpose of "supporting and /or connecting one or more of said constructional elements" by means of "a slight resilient forcing a member of one or more constructional elements." The teachings in Fabre cannot render the present claims obvious because the proposed modification would change the principle of the interlocking operation of the devices in Fabre. See MPEP 2143.01 and the discussion of *In re Ratti*, 270 F.2d 810 and *In re Gordon*, 733 F.2d 900.

In the alternative where this rebuttal argument is rejected, the Applicant submits that it has added new claim 24 with the limitation to the essential function of the invention, being the support or anchor function as described in the first aspect of the invention at page 3, line 27. Engagement between elements is caused by the anchoring of one element in support of a second element. No other interconnectedness function is possible as the claimed protrusions are solid and no socket or depression is claimed. Fabre cannot be used as a reference for obviousness because the Fabre devices cannot be modified in this manner without destroying their principle of operation.

The Applicant has added new claim 25 to describe the preferred embodiment, wherein a solid protrusion extends from the plane of one side and as described in the specification at page 6, line 6 and onward. No depression or complementary socket is claimed for the underside of the card below the protrusion. Instead, the plane of the underside of the card is uniform in the region beneath the protrusion to facilitate the placement of the body portion of a protrusion in abutting contact with the edge of another member in order to anchor the second member and prevent sliding. The Applicant submits that the Fabre reference is distinguishable because a depression with a depth at least one third of the depression diameter is a necessary structural element of claim 1.

The Examiner has rejected claims 1-12 and 14-15 as being anticipated under 35 U.S.C. 102(b) or (e) in view of Wolfe and states that the blocks in Wolfe are "considered to be inherently capable of use as recited in the claims ... since they possess all of the claimed structural elements". The Examiner expressly identifies the uses claimed in the last two paragraphs of claim 1 as support for this objection. In particular, the cited use in the penultimate paragraph of claim 1 teaches the placement of the edge of one element in abutting contact with protrusions on a second element to anchor it and prevent the edge from sliding. The cited use in the final paragraph of claim 1 claims the assembly of a structure by anchoring a first element against the protrusions of another element and leaning the first element against another element and balancing an element on top of one or more other elements.

In response, the Applicant traverses on this issue and has added claims 24 and 25. The Applicant adopts the arguments used above to rebut the anticipation rejection in view of Fabre.

First, the Examiner has not demonstrated how the geometric blocks in Wolfe teach every element of the claim in the present invention as required by 35 U.S.C. 102(b) and MPEP Section 2112.01 and the cases therein.

Wolfe teaches only the connection of the blocks therein by means of engagement of the plurality of protrusions on the

blocks with each other. The specification makes no reference to the two uses cited in the present application. The Examiner has not identified precisely where these limitations appear in the Wolfe reference. Instead, he has merely cited Figures 3 and 5 wherein the side dimension of the blocks is somewhat reduced. The structural elements are not identical to the present invention and no prima facie case of anticipation is established.

Second, the Examiner has not explained the basis for the presumption that the Wolfe blocks are inherently capable of all of the functions claimed by the present invention. This omission is contrary to MPEP Section 2112.

The Applicant submits that the Wolfe reference fails to teach how to practice the two functions cited by the Examiner and does not anticipate the present application. In particular, Wolfe fails to teach the placement of the body portion of a protrusion in abutting contact with the edge of another block in order to anchor the second block and prevent sliding. Wolfe further fails to teach the leaning of one block against another and the balancing of other blocks on top.

The reference does not describe the asserted inherent characteristic. The Examiner must provide extrinsic evidence to make clear that the missing descriptive matter is necessarily present in the Wolfe blocks as required by MPEP 2131.01. Inherency cannot be based on a result that would arise due to optimizing

conditions not necessarily present in the prior art. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish its inherency. This is contrary to MPEP 2112.

In summary, the Applicant submits that the Examiner has failed to explain how the Wolfe blocks are substantially identical to the present invention. The Examiner has further failed to establish inherency with evidence of the missing descriptive matter. The Applicant submits that the burden of proof has not shifted to the Applicant because a prima facie case of anticipation was not provided..

In the alternative, the Applicant submits that it meets the burden of proof to establish that the function is not anticipated by Wolfe. The configuration of the blocks in Wolfe cannot enable placement of a block in abutting contact in the space between two protrusions of a second as claimed. A modification is necessary to effectively reconfigure the blocks as a series of flat cards. This required configuration is not inherent in the Wolfe reference. The Applicant respectfully requests that the objection be withdrawn.

In addition, the Applicant has introduced new limited claims 24 and 25 wherein a rectangular card with solid protrusions is claimed in order to further distinguish these claims from the elements disclosed in Wolfe. The Applicant notes that all elements

are previously described in the disclosure and do not constitute New Matter.

The Examiner has rejected claims 13 and 16-20 as being obvious under 35 U.S.C. 103(a) in view of Wolfe. The Examiner states that the Wolfe reference "discloses most of the elements of the claims, but may not disclose designs comprising words or images on the toy elements or the specific shapes of the protrusions recited in the claims." The Examiner cites "some of the prior art of record" as evidence for his finding that "the missing elements are conventional in the prior art". The Examiner then concludes that "it would have been obvious to one having ordinary skill in the art to provide the device of Wolfe with the noted missing elements for the purpose of rendering the elements more attractive and easier to construct or use."

The Applicant traverses on this issue and has added new claim 25 which includes elements of claims 13, 16, 17 and 19. The Applicant adopts the arguments used above to rebut the obviousness rejection in view of Fabre. The Applicant respectfully submits that the content of the prior art must be determined at the time the invention was made to avoid impermissible hindsight as noted at MPEP section 2141.01. The cited references to the references of Axelrad, Springer, Hluchan cannot apply because the priority date for the present application is November 2, 1999. In addition, the Garganese reference is irrelevant because it is not analogous prior

art for the purpose of analyzing the obviousness of the subject matter at issue. The jewelry display card is not in the field of children's toys nor is it pertinent to the particular problem of assembling card elements together by leaning and stacking. The display card invention would not have logically commended itself to the inventor's attention. The Examiner has not demonstrated that a person of ordinary skill would reasonably be expected or motivated to look to jewelry display cards with posts and bores for a gripping jewelry pin to solve the completely different problem of assembling two or more cards together. See MPEP 2141.01, "Analogy in the Mechanical Arts".

Having regard to the remaining references of Fabre and Gould, the Examiner has not explained why it would be obvious to one of ordinary skill in the art to modify the device of Wolfe to introduce the missing elements, being "designs comprising words or images on the toy elements or the specific shapes of the protrusions recited in the claims". The Applicant respectfully submits that the Examiner's suggestion that these missing elements would be provided for the purpose of rendering the elements of the Wolf device (i) more attractive and (ii) easier to construct and use is not reasonable and unpermitted hindsight.

The Applicant submits that the Examiner has provided a conclusory statement of motivation, that the Wolfe device would be constructed as claimed "for the purpose of rendering the elements

more attractive and easier to construct or use" without any articulated rationale or evidentiary support. The factual finding required by MPEP Section 2144.08 to support an obviousness rejection is not provided.

In addition, the Examiner suggests that the configuration of the blocks in Wolfe could be modified as claimed in claims 13 and 16 to 20 that depend on claim 1. As discussed in the anticipation argument above, a major modification and reduction of the side of the block is required in order to enable it to be placed in abutting contact in the space between two protrusions as claimed. This modification will effectively reconfigure the block as a flat card. Such modification would render the Wolfe blocks unsatisfactory for their identified intended purpose of providing a plurality of blocks of different geometric shapes as noted at column 1, line 59 and column 3, line 6 and claims 2 and 5 of the Wolfe patent. The teachings in Wolfe cannot render the present claims obvious because the proposed modification would change the object of a game with a variety of interconnectable geometric block shapes. See MPEP 2143.01. The Applicant respectfully requests that the objection be withdrawn.

In the alternative where this rebuttal argument is rejected, the Applicant submits that it has added new claim 25 with the limitation to the most essential function of the invention, being the support or anchor function as described in the first

aspect of the invention at [page three line 21], further limited to a rectangular card. Engagement between elements is caused by the anchoring of one element in support of a second element. No other interconnectedness function is possible as the claimed protrusions are solid and no socket or depression is claimed. Wolfe cannot be used as a reference for obviousness because the Wolfe blocks cannot be modified in this manner without destroying the principle of operation using interconnectable blocks in a range of geometric shapes.

Based on the foregoing amendments and remarks, it is respectfully submitted that the claims in the present application, as they now stand, patentably distinguish over the references cited and applied by the Examiner and are, therefore, in condition for allowance. A Notice of Allowance is in order, and such favorable action and reconsideration are respectfully requested.

However, if after reviewing the above amendments and remarks, the Examiner has any questions or comments, he is cordially invited to contact the undersigned attorneys.

Respectfully submitted,

JACOBSON HOLMAN, PLLC

By: *J. Scherer* 22769
for Jonathan L. Scherer
Reg. No. 29,851

400 Seventh Street, N.W.
Washington, D.C. 20004-2201
(202) 638-6666

Date: June 14, 2004
JLS/dmt